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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,748	11/19/1999	WALTER DIEMBECK	BEIERSDORF56	4709

7590 05/28/2002
Norris McLaughlin & Marcus PA
220 East 42nd Street
30th Floor
New York, NY 10017

EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/28/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/367,748

Applicant(s)

DIEMBECK ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/22/02 has been entered.
2. Claims pending are 1-16 and 18.

Claim Rejections - 35 USC § 112

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The rejection of Claims 1, 2, 4-8 and 11-15 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the treatment of rosacea and coperose, does not reasonably provide enablement for the prophylaxis of these conditions, is maintained for the reasons of the record.

Claim Rejections - 35 USC § 102

5. The rejection of Claims 1-4, 7-11 and 14-16 under 35 U.S.C. 102(b) as being anticipated by Giacomoni is maintained for the reasons of the record. New Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Giacomoni for the same reasons.

Claim Rejections - 35 USC § 103

6. The rejection of Claims 5, 6, 12 and 13 under 35 U.S.C. 103(a) as being unpatentable over Giacomoni in view of either Breton et al. or Ptchelintsev et al. is maintained for the reasons of the record.

Response to Arguments

7. Applicant's arguments filed 4/22/02 have been fully considered but they are not persuasive.

With respect to the enablement rejection, the Applicant argues that “[a] person skilled in the art would have been reasonable in the expectation that NO-synthase inhibitors might also have been effective in preventing rosacea and couperose.” In response, it is noted that the *reasonable expectation* that the NO-synthase inhibitors might be effective in preventing the skin conditions is not sufficient; the Applicant has to submit *an evidence* that the NO-synthase inhibitors are, in fact, effective in preventing rosacea and couperose.

With respect to the 102 rejection over the Giacomoni reference, the Applicant argues that Giacomoni fails to anticipate Claims 1-4, 7-11 and 14-16 because his compositions are not necessarily formulated and applied as claimed in the instant claims. In response, it is noted that the Giacomoni reference explicitly teaches applying to the skin of a person a cosmetic composition containing NO-synthase inhibitors of the instant invention in combination with a cosmetic or pharmaceutical substance. See Abstract. The compositions of Giacomoni are used for the treatment of rosaceous acne. See p. 7 of the translation. The applicant is reminded that the reference's disclosure is not limited to examples or preferred embodiment and must be considered as a whole. Thus, Giacomoni explicitly teach treating rosaceous acne with

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compositions containing a NO-synthase inhibitor in combination with a retinoid. Further, the effective amount of NO-synthase inhibitors in the compositions of Giacomoni significantly overlaps with that of the instant invention. See Claim 2 of the translation and p. 7 of the instant specification.

Conclusion


8. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml
5/21/02


JOSE G. DEES
SUPERVISORY PATENT EXAMINER
1616